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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Susan Opalka et al.)
Serial No.: 09/785,611) Ex: SWENSON
Filed: 05 June 2004) Art Unit: 3618
For: AMBULATORY APPARATUS AND)
METHOD OF MANUFACTURE)
THEREOF)

CERTIFICATE OF MAILING

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Dear Sir:

I hereby certify that the attached Transmittal Letter; Appeal Brief and two (2) copies; Check for appropriate fees; and a postcard are being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria VA 22313-1450, Mail Stop Appeal Brief-Patents, on 01 July 2004.

W. E. Edmuth
Signature

01 July 2004

01 July 2004
Date

Respectfully submitted,

Robert A. Parsons

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TRANSMITTAL OF APPEAL BRIEF

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Dear Sir:

Enclosed is the Brief on Appeal and two copies of the same, in compliance with the Rules, in the above captioned matter, and a check in the amount of \$165.00, the requisite fee set forth in 37 CFR 1.17(c).

Respectfully submitted,

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01 July 2004

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Date: 5 June 2004

Opalka et al.

Art Unit: 3618

Serial No.: 09/785,611

Filed: 16 February 2001

Examiner: Swenson, Brian

For: AMBULATORY APPARATUS AND
METHOD OF MANUFACTURE THEREOF

BRIEF FOR APPELLANTS

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

SIR:

Please consider the contents of the following Brief for Appellants.

I. REAL PARTY IN INTEREST

All of the right, title and interest in and to the above-described Patent Application are owned by appellants.

07/08/2004 RMEBRAHT 00000048 09785611

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II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences related to the above described Patent Application.

III. STATUS OF THE CLAIMS

1. A copy of claims 12-19, all of the claims in the application, is provided in Appendix A.
2. Claims 12, 14, 15, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sokolis et al. (U.S.P. 5,339,853) in view of McDonald (U.S.P. 5,191,995).
3. Claims 13, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sokolis et al. (U.S.P. 5,339,853) in view of McDonald (U.S.P. 5,191,995) and further in view of Chen (U.S.P. 6,318,392).

IV. STATUS OF AMENDMENTS FILED SUBSEQUENT TO FINAL
REJECTION

Appellants did not respond to a Final Rejection mailed 9 February 2004. No amendments were attempted subsequent to the Final Rejection.

V. EXPLANATION OF THE INVENTION

The application on appeal discloses and claims ambulatory apparatus 30, illustrated in FIG. 4, and ambulatory apparatus 50, illustrated in FIG. 6, with the design and function described and explained on page 11 and pages 12-14, respectively, of the present specification.

The ambulatory apparatus (30, 50) includes a frame work (31, 51) for supporting an individual and aiding ambulation thereof. The framework (31, 51) has opposing handle ends (35, 55) and foot ends (33, 53) with at least one tubular segment (36) of transparent material. Specifically, framework 31 includes at least one separate handle 34, for grasping by the individual, coupled to and closing handle end 35 of framework 31 and decorative filling 37 carried within the at least one tubular segment 36.

In the embodiment of FIG. 6, framework 51 has several tubular members each with a window 81 therein so that tubular segments of transparent material can be filled or otherwise decorated with decorative material, thereby forming decorative elements 80, and carried within the tubular members so as to be visible through windows 81. The purpose of the invention is to enhance the overall appearance of apparatus 30 or 50 with the visibly positioned decorative material.

VI. ISSUES FOR REVIEW

The first issue is whether claims 12, 14, 15, 18, and 19 are patentable over Sokolis et al. (U.S.P. 5,339,853) in view of McDonald (U.S.P. 5,191,995)?

The second issue is whether claims 13, 16, and 17 are patentable over Sokolis et al. (U.S.P. 5,339,853) in view of McDonald (U.S.P. 5,191,995) and further in view of Chen (U.S.P. 6,318,392)?

VII. GROUPING OF CLAIMS

Claim 12 and dependent claim 13 are method claims. Claims 14 and dependent claims 15-17 are drawn to a kit for decorating ambulatory apparatus. Claim 18 and dependent claim 19 are drawn to decorated ambulatory apparatus. Appellants believe the claims should be divided and argued accordingly.

VIII. ARGUMENT**Issue #1**

Claims 12, 14, 15, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sokolis et al. (U.S.P. 5,339,853) in view of McDonald (U.S.P. 5,191,995). Appellants respectfully traverse this rejection.

Appellants have invented new and novel ambulatory apparatus that is decorated to enhance the overall appearance. Ambulatory apparatus, at best, can be depressing and not particularly artistic. In accordance with the present invention, the ornamentation or decoration of each apparatus with decorative elements may be expressed with one or more of color, texture, drawings or patterns, carvings, figures or shapes, light reflection, etc. In this way each individual can decorate their ambulatory apparatus to fit their likes, personality and particular character. Clearly, to fulfill the objective of the invention it is important that the ornamentation or decoration be visible to anyone viewing the ambulatory apparatus.

The very first consideration that must be made in either of the issues is whether McDonald is analogous art. Appellants strongly argue that McDonald is improperly combined, because it is non-analogous art and thus lacking in any incentive for the combination. The CCPA has explained the policy as follows:

In resolving the question of obviousness under 35 U.S.C. 103, we presume full knowledge by the inventor of all the prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved. The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art. (*In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979)).

In order to determine if a reference is reasonably pertinent, the Federal Circuit has stated that:

[a] reference is reasonably pertinent if ... it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering his problem If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem [I]f it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it. (*In re Clay*, 966 F.2d 656, 23 USPQ 2d 1058, 1060-61 (Fed. Cir. 1992))

McDonald does not have a purpose that is even remotely similar to the purpose of the claimed invention. The purpose of McDonald is to store and dispense golf balls from a tube,

which may be straight or cane shaped, carried in a golf bag. The invention as claimed is an ambulatory device having structure and problems completely unrelated to a golf ball dispenser. Thus, McDonald would not be considered and is improper for use as a 35 U.S.C. 103 reference.

The Examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for the rejection of an applicant's invention the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problems with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

The Examiner admits that *In re Oetiker* is controlling but then, instead of applying the precepts stated therein, he erroneously determines (somehow ?) that the ambulatory cane of Sokolis et al. can be combined with McDonald's teaching because McDonald shows a cane shaped golf ball storage device. On page 5 of the Final Rejection, the end of the first full paragraph, the Examiner states "McDonald teaches of a storage device, in Figure 1 that is disclosed to be a cane (Col. 3, line 65). This statement is so erroneous that it borders on disrespect for appellants' intelligence.

McDonald does not even suggest that he has disclosed a cane. At column 3, line 65 McDonald states "dispenser 20 includes a cane shaped tube 21 as a housing" (accent added). Later in a statement generalizing the embodiment (col. 6, lines 37-39), McDonald states "Which tubular housing has been shown as either being a straight tube or a tube that is bent into a cane shape." Nothing in the disclosure of McDonald at any time ever suggests that he is disclosing a cane that can be used for ambulatory purposes. Thus, since McDonald does not disclose a cane at column 3, line 65 or anywhere else, appellants strongly assert that the Examiner's argument must fail and McDonald is nonanalogous art. Further, since McDonald is nonanalogous art any combination with the teaching of Sokolis et al. to arrive at appellants' novel structure is improper per *In re Oetiker*.

On page 3, sixth line (first full paragraph), the Examiner admits that Sokolis et al. do not teach filling the hollow leg, of their ambulatory device, with items. Since any combination of McDonald's teaching with the teaching of Sokolis et al. is improper, it is clear that the rejection of appellants' novel ambulatory apparatus as obvious must fail. However, for purposes of argument only appellants will continue with a response to the Examiner's rejections.

Turning to the claims in this group, claim 12 is a method claim which details a method of forming a framework having forward and rearward legs, the method includes the steps:

"providing a decorative element; providing at least one of the forward and rearward legs with a window; positioning the decorative element within the one of the forward and rearward legs; and securing the decorative element to the one of the forward and rearward legs so that the decorative element is capable of being viewed through the window."

As noted by the Examiner, Sokolis et al. do show some embodiments of their ambulatory device with windows 10 adjacent the "lowermost distal end" (Sokolis et al. specification, abstract and col. 3, lines 32-38). The only purpose of the windows is "for projecting illumination from the support leg through the windows for assistance in use of the walking device." (Sokolis et al. Abstract) Clearly, even if, *arguendo*, a decorative element were placed in the leg or legs of the Sokolis et al. device, it would not be "capable of being viewed through the window", as required by appellants' claim 12, since the viewer would have to lay his head flat on the sidewalk to even be near the window.

To establish the *prima facie* case of obviousness, which the Examiner must establish, the first basic criteria that

must be met is to show some suggestion or motivation to modify the references or to combine reference teachings to arrive at appellant's claimed method. No suggestion or motivation to cure the problem solved by appellant's invention is included anywhere in either Sokolis et al. or McDonald. Further, the references when combined must teach or suggest all of the claim limitations. Again, there is no suggestion or motivation to combine the teachings of Sokolis et al. and McDonald to result in the claimed invention.

The windows of Sokolis et al. are provided to allow light to be emitted onto the users' pathway. If the windows are filled with the golf balls of McDonald, no light will be emitted and the Sokolis et al. night light apparatus will be inoperable. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

The Examiner attempts to counter this argument with his judicial notice that illuminating golf balls are well known in the art and could be used as decorative filler while still providing the Sokolis et al. objective of providing illumination (Final Rejection, page 5, end of the first

paragraph). Of course the Examiner completely ignores the fact that the Sokolis et al. light system would have to be removed (including switch 18 and batteries 27) to make way for the golf balls. This argument raises several important issues. The art being considered is ambulatory apparatus. Neither illuminated golf balls nor, for that matter, any kind of golf balls are well known in the ambulatory art. If the Examiner thinks differently, appellants hereby specifically request an affidavit supporting this argument and citing any appropriate citations (37 C.F.R. § 1.107(b)(1993)).

Further, even if the Examiner can show that illuminated golf balls are well known in the ambulatory art, he still must show some suggestion or motivation to make the proposed modification. What would lead the skilled artisan in the ambulatory art to fill the Sokolis et al. legs with illuminated golf balls other than, possibly, proscribed hindsight using appellants' teaching? Also, appellants believe that the Examiner must show some proof that illuminated golf balls actually project illumination sufficient to light a pathway, simple illumination for purposes of finding the ball in the dark is not necessarily sufficient. Again, appellants specifically request an affidavit supporting the Examiner's argument and citing any appropriate citations.

In view of the fact that any combination of Sokolis et al. and McDonald would be improper, either because the Examiner's burden of proving *prima facie* obviousness has not been met or because the final product would be inoperative or worse, appellants believe that claim 12 is allowable.

Turning now to Claim 14 (and dependent claim 15), the claim states

A kit of component parts capable of being assembled into a device for aiding a user in going on foot comprising a combination of: decorative elements including transparent tubular segments carrying decorative filler; and a framework having windows and opposing footed and handled ends and adapted to removably accommodate each of the decorative elements so that they may be viewed through the windows.

Clearly, neither Sokolis et al. nor McDonald disclose or even suggest "a kit of component parts capable of being assembled into a device for aiding a user in going on foot". "All words in a claim must be considered in judging patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494. 496 (CCPA 1970). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871

(Fed. Cir. 1983); *Schenck v Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Considering all of the words in claim 14 and the invention as a whole, appellants' claimed invention is clearly substantially different than the structure and teaching of either Sokolis et al. or McDonald individually or in any proper combination. Therefore, appellant believes that claims 14 and 15 are allowable.

Turning now to claim 18 (and dependent claim 19), the claim states

Ambulatory apparatus comprising: a frame work having opposing handle and foot ends for supporting an individual and aiding ambulation thereof; the framework including at least one tubular segment of transparent material; at least one separate handle, for grasping by the individual, coupled to and closing the handle end of the framework; and decorative filling carried within the at least one tubular segment.

Considering all words of the claim and the invention as a whole, the framework of the ambulatory apparatus must include "at least one tubular segment of transparent material" and "decorative filling carried within the at least one tubular section." The Examiner admits that "Sokolis et al. do not teach of filling the hollow leg with items." Further, if the hollow legs of Sokolis et al. included decorative filling the invention would be inoperative for its intended purpose since the internal light would not project illumination onto a

pathway. In fact, if the tubular section were filled with illuminated golf balls, as suggested by the Examiner, light 26, switch 18, and batteries 27 would have to be removed to make way for the golf balls. From a practical stand-point it must be noted that the golf balls would be on continually, which would quickly dissuade any skilled artisan from making the modification.

First, because McDonald is nonanalogous art, the modification, produced by combining Sokolis et al. with McDonald, suggested by the Examiner is improper. Second, if the golf balls of McDonald were stored in the Sokolis et al. ambulatory cane, the cane would not operate as intended and, therefore, the combination is improper. Third, to store the McDonald golf balls in the body (or legs) of either Sokolis et al. device would require substantial modification (i.e. removal of light 26, switch 18, and batteries 27, along with the wiring), which is not suggested in either Sokolis et al. or McDonald. Finally, if the substantial modifications were made to the Sokolis device, the operator (user) would not be able to actuate the light, it would either be on all the time or off all the time. Clearly, the suggested modification or combination is improper and claims 18 and 19 are allowable.

Issue #2

Claims 13, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sokolis et al. (U.S.P. 5,339,853) in view of McDonald (U.S.P. 5,191,995) and further in view of Chen (U.S.P. 6,318,392). Appellants respectfully traverse this rejection.

Claim 13 depends from claim 12 and is not obvious in view of any proper combination of Sokolis et al. and McDonald for the reasons given above. Also, claims 16 and 17 depend from claim 14 and are not obvious in view of any proper combination of Sokolis et al. and McDonald for the reasons given above.

Chen discloses a supportive walker and was cited for the disclosure of wheels attached to the footed ends of the walker, as well as the wire storage bins. However, nothing in the disclosure of Chen can be used to overcome the shortcomings of Sokolis et al. and McDonald or to make the Examiner's suggested combination of those two teachings proper. Thus, claims 13, 16, and 17 are not obvious in view of any proper, or possible, combination of Sokolis et al., McDonald, and Chen. Therefore, appellants believe that claims 13, 16, and 17 are allowable.

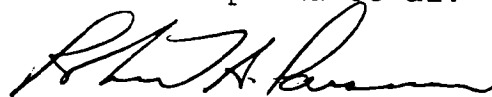
SUMMARY

The suggested combination of the teachings of Sokolis et al. and McDonald is improper for several reasons. First, because McDonald is nonanalogous art, the suggested combination of Sokolis et al. with McDonald is improper. Second, if the golf balls of McDonald were stored in the Sokolis et al. ambulatory cane, the cane would not operate as intended and, therefore, the combination is improper. Third, to store the McDonald golf balls in the legs of the Sokolis et al. device would require substantial modification (i.e. removal of light 26, switch 18, and batteries 27, along with the wiring), which is not suggested in either Sokolis et al. or McDonald. Finally, if the substantial modifications were made to the Sokolis device, the operator (user) would not be able to actuate the light, it would either be on all the time or off all the time. Thus, the combination of Sokolis et al. with McDonald is improper.

Accordingly, it is respectfully asserted that appellants' claims 12-19 are clearly allowable and the case is now in condition for allowance. Appellants therefore pray for the reversal of the final rejection and the allowance of the subject application.

Respectfully submitted,

Susan Opalka et al.

A handwritten signature in black ink, appearing to read 'Robert A. Parsons', is written over the printed name.

Robert A. Parsons

Attorney for Appellants

Registration No. 32,713

01 July 2004

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APPENDIX A

12. In a framework of attached forward and rearward hollow legs having upper ends, lower ends, handled structure attached to the upper ends and feet each attached to one of the lower ends, a method comprising steps of:

providing a decorative element;

providing at least one of the forward and rearward legs with a window;

positioning the decorative element within the one of the forward and rearward legs; and

securing the decorative element to the one of the forward and rearward legs so that the decorative element is capable of being viewed through the window.

13. The method of claim 12, wherein the step of providing a decorative element further includes the step of providing a transparent receptacle containing decorative filling.

14. A kit of component parts capable of being assembled into a device for aiding a user in going on foot comprising a combination of:

decorative elements including transparent tubular segments carrying decorative filler; and

a framework having windows and opposing footed and handled ends and adapted to removably accommodate each of the decorative elements so that they may be viewed through the windows.

15. The kit of claim 14, wherein the handled end comprises opposing handles, which are directed toward the footed end.

16. The kit of claim 14, wherein the footed end is wheeled.

17. The kit of claim 14, further including a storage bin adapted to be affixed to the framework.

18. Ambulatory apparatus comprising:

a frame work having opposing handle and foot ends for supporting an individual and aiding ambulation thereof;

the framework including at least one tubular segment of transparent material;

at least one separate handle, for grasping by the individual, coupled to and closing the handle end of the framework; and

decorative filling carried within the at least one tubular segment.

19. Ambulatory apparatus as claimed in claim 18 wherein the framework further includes:

at least one tubular member having a window therein;

the at least one tubular segment of transparent material carried within the at least one tubular member and visible through the window.